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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,655	03/25/2004	Zhonglin Hao	00497-09	8524

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UNIVERSITY OF VIRGINIA PATENT FOUNDATION
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CHARLOTTESVILLE, VA 22902

EXAMINER

ROOKE, AGNES BEATA

ART UNIT PAPER NUMBER

1653

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/809,655

Applicant(s)

HAO ET AL.

Examiner

Agnes B Rooke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10,11,15-18,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10,18 and 30 is/are rejected.
- 7) ☒ Claim(s) 11 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This is in response to the Applicant's election without traverse of Group I, Claims 10, 11, 18, 30, and 31, drawn to a polypeptide of SEQ ID NO:9, on 03/28/2005.

Claims 1-9, 12-14, and 19-29 have been cancelled.

Claims 15-17 are withdrawn from consideration because they refer to non-elected claims.

Claims 10, 11, 15-18, 30, and 31 are pending.

Claims 10, 11, 18, 30 and 31 are currently under examination.

The restriction requirement is still deem proper and is therefore made final.

A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP, paragraph 821.01.

This application claims priority from 60/176,885, filed January 19, 2000.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10, 18, and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In Claim 10, the Applicant claims an amino acid sequence that differs from SEQ ID NO:9 by a single mutation, wherein the single mutation represents a single amino acid deletion, insertion or substitution. Also, it is not clear whether the polypeptide is purified or recombinant, since the Applicant uses the word "or" in the claim. The claim does not satisfy the written description requirement because the structure of the amino acid with its mutation(s) is not provided. Thus, the structure of the polypeptide does not correlate with its function.

In Claim 18, the Applicant refers to an antigenic composition comprising a SAMP32 polypeptide, however there is no structure or function that corresponds to the SAMP32 polypeptide. Therefore, the claim does not satisfy the written description requirement.

In Claim 30, the Applicant refers to a fragment of SEQ ID NO:9, but a fragment of an amino acid sequence could be, for example, an active lysine. The claim does not satisfy the written description requirement because the fragment of the SEQ ID NO:9 is not specifically provided, and thus the structure of the polypeptide does not correlate with its function.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Kokolus et al. (U.S. 5,807,978).

Kokolus et al. teach prostate specific antigen that is seminal plasma protein. See column 1, line 30-31; where the seminal protein is used in the form of antigenic composition for the immunization of animals. See column 9, line 63-64.

Therefore, it would have been obvious to a person skilled in the art to take a seminal plasma protein, such as SAMP32, and use it in an antigen compositions as taught by Kokolus et al. because the method of developing immunologic reagents by using antigen compositions is known in the art.

Conclusion

SEQ ID NO:9 is free of art.

Claims 11 and 31 are objected to because they depend from rejected independent claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Agnes Rooke whose telephone number is 571-272-2055. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

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A handwritten signature in cursive script that reads "Karen Cochrane Carlson" followed by a stylized "PD" monogram.

KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER